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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,923	08/27/2003	Anthony Dezonno	6065-86942	4105
24628 7590 11/12/2008 Husch Blackwell Sanders, LLP Welsh & Katz 120 S RIVERSIDE PLAZA 22ND FLOOR CHICAGO, IL 60606				
EXAMINER				
HA, DAC V				
ART UNIT		PAPER NUMBER		
2611				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/648,923

Applicant(s)

DEZONNO, ANTHONY

Examiner

Dac V. Ha

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This is in response to the amendment filed 07/24/08.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-50** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gregorek et al. (US 5,557,658) (hereafter Gregorek) in view of He (US 5,642,407).

Regarding claim 18, Gregorek discloses all claimed subject matter "means for suppressing at least one audio tone notifying a user of a receiving communications device that a connection is in the process of being established; and means for substituting information unrelated to the at least one suppressed audio tone to a user of the receiving communications device while the connection is in the process of being established" in Abstract; col. 2, line 62 to col. 3, line 12. Further, Gregorek discloses the substitute information based "upon the user's preference" in col. 2, lines 24-29; col. 13, lines 54-60.

Gregorek differs from the claimed invention in that it doesn't teach the claimed subject matter "wherein the information is automatically configured based upon a profiled the user generated by monitoring the user's use of the communication device and the user's preference". However, in the same field of endeavor, He teaches such claimed subject matter in col. 1, lines 51-59; col. 3, lines 26-56; col. 4, line 46 to col. 8,

line 12. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the teaching of automatically presenting advertisement to caller according to caller's "profile" into Gregorek to further optimize the efficiency of the advertisement.

Regarding claim 1, see claim 18 above. Further, He further suggests the teaching of the claimed subject matter "the information is downloaded during a completed communication immediately preceding the connection being established" in col. 3, line 26 to col. 6, line 58. That is, He stores records in the predicate table. These records relates to particular caller and are loaded during a connection is being established. Therefore, it would have been easily realized by one skilled in the art that those records could have included one "during a completed communication immediately preceding the connection being established".

Regarding claim 34, see claim 18 and similar analogy with that in claim 1 applies.

Regarding claims 30, 17, 35, see claim 1 above.

Regarding claims 19, 2, 36, Gregorek further discloses "the information includes advertisements, music, movie clips, news headlines, sports scores, stock quotes, weather, time of day, calendar reminders, horoscopes, messages, and inspirational sayings" in col. 12, lines 17-27.

Regarding claims 20, 3, 37, Gregorek further discloses "the information is conveyed in audio, visual, or audio-visual format to the user" in col. 12, lines 17-27.

Regarding claims 21, 4, 38, He further discloses "wherein the information comprises verbal messages describing the connection process" in Table 1.

Regarding claims 22, 5, 39, He further discloses "wherein the information ... display associated with the at least one communication device" in col. 6, lines 14-16.

Regarding claims 23-29, 31-33, 6-16, 40-50, these claimed subject matter would have been easily realized by one skilled in the art at the time of the invention as preference/application specific based on the aforementioned combination. That is, in the aforementioned combination, while establishing a connection, action is executed from an action list in relation to the caller attributes. He lists some of the action that could be taken in Table 1, however, there actions are merely examples, one skilled in the art would have easily realized that any other appropriate actions could have been included, depending each particular situation, so as to maximize the revenue generation during the time the connection is being established.

Response to Arguments

4. Applicant's arguments filed 07/24/08 have been fully considered but they are not persuasive.

Applicant, on pages 12-13 of the REMARKS, has argued:

"Claims 1-50 have been rejected as being obvious over Gregorek and He. Gregorek describes transmitting pre-recorded announcements during a telephone call to the caller in lieu of dial tone, ring back, or busy signals. All the independent claims (claims 1, 17, 18, 34, and 35) call for automatically configuring the information based upon a profile generated by monitoring the user's use of the device and/or the user's preferences. This feature, as conceded by the Office Action, is not taught or suggested by Gregorek. However, the Office Action asserts that it is disclosed by He at Col. 1, lines 51-59; Col. 3, lines 26-56 and Col. 4, lines 46-Col. 8, line 12.

He describes a system for an audio response to the caller of an unsuccessful connection attempt. He does not disclose configuring substitute information based on a profile of the user from monitoring the user's use of the device, rather it describes a process for deciding which calls should be selected as unsuccessful calls (Col. 1, lines 55-56; Col. 3, lines 30-31) and is concerned only with unsuccessful attempts at connection. Thus, it does not teach configuring information which is substituted while the connection is being established, and does not use a user profile generated by monitoring the user's use of the communication device. The passage at Col. 1, lines 51-59 cited by the Office Action merely describes playing audio advertisements to selected callers of unsuccessful attempted connections and identifying which callers should be selecting unsuccessful callers to be played ads but does not describe configuring information to be presented, or a profile generated by monitoring the user's use or the user's preferences. The cited passage at Col. 3, lines 26-56 merely describes a predicate action table which identifies specific callers based on attributes associated with an unsuccessful attempted connection. Again, there is no mention of configuring information, or a profile based on monitoring user's use or preferences, only description of identifying selected callers of unsuccessful attempts. Further, the table lists only messages indicating no connection can be made (i.e., line is busy) and thus does not describe information to be substituted while the connection is being established. The cited passages at Col. 4, lines 46 to Col. 8, line 12 merely describes the process of selecting a caller for a busy message after the determination that no connection can be made (i.e., the line is busy). Thus, there is no disclosure in He of configuring information to be substituted while the connection is being established or of a profile-based on monitoring user's use of the communication device and the user's preferences. Thus, the combination of Gregorek and He does not teach all of the claimed features of the independent claims."

On the outset, Gregorek and He both seek to provide advertisements as a revenue supplement during period that a call is being established. This includes when the callee is busy; off-hook; temporarily switch to a different call; unsuccessful calls; etc. (Gregorek; col. 1, lines 23-63; He, col. 2, lines 34-37). Therefore, an unsuccessful call is clearly a result of one of the above condition, thus He also directs to the same field as that of the present claimed invention. Moreover, applicant has argued "He does not disclose configuring substitute information bases on a profile of the user from monitoring the user's use of the device; rather it describes a process for deciding which calls should be selected as unsuccessful calls" "and is concerned only with

unsuccessfull calls". However, He discloses "configuring substitute information" by determining first a condition and associated action list to be executed (col. 1, lines 54-65; Table 1). Generally, the predicate action table defines a list of actions that corresponds to specified conditions (col. 3, lines 26-27). Further, caller attributes and telephone call attributes are monitored and utilized for setting conditions and actions to be taken (col. 4, line 64 to col. 5, line 34; col. 3, lines 3, lines 27-53; col. 5, lines 48-57). In summary, He explicitly discloses "configuring substitute information bases on a profile of the user from monitoring the user's use of the device".

Applicant further has argued, on page 13 of the REMARKS:

"With regard to claim 18 and the dependent claims 19-33, the claims call for suppressing tones of a user of a receiving communication device, and substituting to a user of the receiving communication device. Gregorek and He do not disclose this feature. Gregorek concerns providing announcements to the caller not the receiving device, Col. 3, lines 4-5; He also does not concern or describe substituting information to a receiving device. Thus, claim 18 and dependent claims 19-33 are further distinguishable over the cited references for this reason."

However, Gregorek and He both directs to method for replacing the dial tone, which would have been normally sent to the party initiating a connection, with other information, i.e. advertisements (Gregorek; Abstract; col. 2, lines 11-15; col. 3, lines 47-51; He; col. 6, lines 59-61; col. 8, lines 5-7).

On pages 13-14, applicant has argued:

In addition, independent claims 1, 17, and 35 call for downloading the information during an immediately preceding communication. This feature is not disclosed by Gregorek or He. The Office Action asserts that He suggests this in Col. 3, line 26 to Col. 6, line 58, because He stores records in the predicate table which relate to the caller and are loaded during a connection. However, as described above, these records are not information substituted while the connection is being established, nor is there any disclosure that they are downloaded during a completed communication immediately preceding the connection being established. In He there is no connection being

established, it has been determined that a connection cannot be established. Further, He describes the predicate list and its maintenance in detail, but never mentions or suggests that it or any information to be substituted is downloaded during a preceding completed communication. Thus, independent claims 1, 17, and 35 and dependent claims 2-16 and 36-50 are believed to be further distinguishable over the cited references for this reason."

As explained previously, the records themselves are not the "substitute information", however, based on those records, conditions and actions to be taken are defined. The kind of action to be executed, which details the "substitute information", is directly related to "an immediately preceding communication" (col. 6, lines 8-41).

On page 14, applicant has argued:

"Claim 34, as well as dependent claims 9, 26, and 45, are limited to updating at predetermined time intervals. This feature is also not disclosed or suggested by Gregorek or He."

However, He discloses the "updating" by modifying a condition field in col. 6, line 18 and at intervals determined by cycle of the predicate table maintenance.

"Claims 4, 21, and 38 further claim verbal messages which describe the connection process. The Office Action asserts that He discloses this in Table 1. However, Table 1 only concerns a busy line and includes only "busy" messages. Thus, it has messages informing the user that no communication process can be conducted, but does not have messages describing the connection process. For these reasons, claims 4, 9, 21, 26, 34, 38, and 45 are believed to be further distinguishable over the cited references. Thus, the independent claims 1, 17, 18, 34 and 35 are believed to be distinguishable over Gregorek and He, and are therefore not rendered obvious by the combination of Gregorek and He. In addition, the dependent claims 2-16, 19-33 and 36-50 are believed to be allowable because they depend from allowable base claims 1, 18, and 35."

He implicitly discloses "verbal messages which describe the connection process" in Table 1, Condition 1.

Applicant has continued:

"Further, dependent claims 13, 30, and 46 claim downloading from an outside source after the communication is established and subsequently substituting in future

attempts to establish communications. Dependent claims 15, 32, and 47 claim updating only upon connection of the devices. These features are not described or suggested by Gregorek or He. Thus claims 13, 15, 30, 32, 46, and 47 are believed to be further allowable over the references of record."

As indicated in the office action above and previously, claimed subject matter in claims, 13, 30, and 46 for example, would have been easily realized by one skilled in the art based on the aforementioned combination. That is, the content of the advertisements change (because change in contract or agreement between the telephone company and the company who want to advertise or change in user profile/preference). Therefore, these new information will need to be changed accordingly and should be used in future attempts to establish communication.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dac V. Ha whose telephone number is 571-272-3040. The examiner can normally be reached on 4/4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Payne can be reached on 571-272-3024. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dac V. Ha/
Primary Examiner, Art Unit 2611